

REMARKS

The Office Action dated May 10, 2006, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto. The Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the following remarks.

By this amendment, Claim 10 has been amended. The Applicants submit that the amendments made herein are fully supported in the specification, claims and the drawings, as originally filed, and therefore no new matter has been introduced. Claims 1-10 are subject to examination and pending in the present application.

Claim Objections

Claim 10 is objected to as containing informalities. Claim 10 has been amended responsive to this rejection. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the objection.

Rejection Under 35 U.S.C. § 112

Claims 1-10 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In making this rejection, the Office Action takes the position that the function blocks described in pages 1-3 of the specification appear to be software. The Applicants disagree with the Examiner's assertion, and respectfully traverses the rejection.

The Applicants submit that the written description of the present application is in full, clear, concise, and exact terms to enable a person skilled in

the art to make and use the present invention in accordance with 35 U.S.C. § 112, first paragraph.

For example, the specification discloses control signals b and a, which may be chip enable signals to the function blocks 16 and 17, respectively (see Specification, page 6, lines 23-25). The specification further discloses that the chip select signal CS serves to select the function block 16 during routine and normal operations, and, when both the chip select signal CS and the control signal b are "1", the and circuit 30 supplies "1" to the function block 16 as an activated chip select signal CS (see Specification, page 10, lines 8-19). These portions of the specification, for example, illustrate that the function blocks may be controlled by binary control signals, which is a feature usually characteristic of hardware implementations.

Accordingly, the Applicants submit that **a plurality of hardware function blocks**, as recited in Claim 1, for example, and other claim features relating to hardware function blocks, are sufficiently defined in specification to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time of filing.

As such, the Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection Under 35 U.S.C. § 102(b)

Claims 1-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Guthery (U.S. Patent No. 6,567,915). To the extent this rejection remains

applicable to the claims currently pending, the Applicants respectfully traverse the rejection.

Claim 1, as amended, recites a semiconductor integrated circuit, including a plurality of hardware function blocks, a nonvolatile memory unit which stores coded license information indicative of a usable/unusable status separately for each of the plurality of hardware function blocks, and a decoder circuit which decodes the license information stored in the nonvolatile memory unit and makes each of the hardware function blocks separately either usable or unusable depending on the decoded license information.

The Applicants submit that the applied prior art fails to disclose or suggest all the elements of amended Claim 1. Specifically, Guthery fails to disclose or suggest at least a semiconductor integrated circuit which **makes each of the hardware function blocks separately either usable or unusable** depending on the decoded license information.

The Office Action cites the authentication table of Guthery disclosed at col. 7, lines 1-67, and the Instantaneous Authentication Command disclosed at col. 11, lines 1-67, as allegedly teaching this element.

However, the authentication table of Guthery holds a list of authenticatable identities, such as people, entities, agencies, code, hardware, etc. (see Guthery, col. 7, lines 25-27). The authentication table also correlates these identities with information describing how particular identities are authenticated (see Guthery, col. 7, lines 55-61). For example, in the given example of a smart card configured to engage in bank transactions, purchase groceries, and rent movies,

the authentication table lists a card holder, a video store, a bank, and a grocery store as identities (col. 8, lines 3-7). The Applicants submit that the authentication table has nothing to do with hardware function blocks, and thus cannot disclose or suggest at least this element.

The Instantaneous Authentication Command disclosed by Guthery passes sufficient information to the card to enable authentication and instructions to perform a specified transaction. Namely, when a command requesting a specific Operation is received under a certain identity name, the smart card authenticates the named identity based on the authentication table, and performs the requested operation if the authenticated identity can perform the operation. The Applicants submit that this operation performed by the smart card is not a hardware-function-block specific operation, but is instead a software based operation performed by the CPU 52 (see Guthery, Fig. 2, which shows that a smart card includes only a CPU 52, a RAM, a ROM, an EEPROM, and a Reader Interface).

Accordingly, the Applicants submit that Guthery fails to teach or suggest all the elements of amended Claim 1.

To qualify as prior art under 35 U.S.C. § 102(b), a single reference must teach, i.e., identically describe, each feature of a rejected claim. For the reasons provided above, the Applicants respectfully submit that Guthery does not teach or suggest each and every feature recited by Claim 1. Accordingly, Claim 1 is not anticipated, nor rendered obvious in view of, Guthery.

As such, the Applicants respectfully submit independent Claim 1 should be deemed allowable. As Claim 1 is allowable, the Applicants submit that claims 2-9, which depend from claim 1, are likewise allowable for at least the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein.

Rejection Under 35 U.S.C. § 103(a)

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Guthery, and further in view of Iguchi (U.S. Patent No. 6,198,669). The Applicants respectfully traverse the rejection.

With respect to Claim 10, Iguchi is applied as allegedly teaching nonvolatile memory receiving information from an external LSI tester (see Office Action, page 7). However, the Applicants respectfully note that Iguchi, alone or in combination with Guthery, fails to teach or suggest at least a semiconductor integrated circuit which makes each of the hardware function blocks separately either usable or unusable depending on the decoded license information, as recited in amended Claim 1. In other words, Iguchi fails to overcome or otherwise address the deficiencies of the applied prior art with regards to Claim 10.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. For at least the reasons provided above, Applicants submit that Guthery in view of Iguchi, either alone or in combination, do not teach or suggest all the elements of Claim 10.

Accordingly, the Applicants submit that Claim 10 is allowable over the applied prior art.

Further, with regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3. This is an insufficient showing of motivation.

Accordingly, the Applicants respectfully request withdrawal of the rejection.

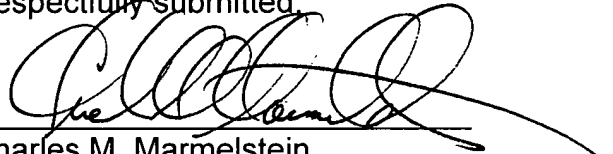
Conclusion

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding objections and rejections, allowance of Claims 1-10, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 **referencing Attorney Docket No. 100353-00093.**

Respectfully submitted,



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